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DOCKET NO. 57714

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Semple, et al.  
Serial No.: 08/837,042  
Filed: April, 11, 1997  
For: GnRH ANTAGONISTS  
Group Art Unit: 1654  
Examiner: C. Delacrois-Muirhead

I hereby certify that this paper is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Attn: Group Director, Washington, D.C. 20231, on this date.

10/13/98

Date

James J. Schumann

Registration No. 20,836

Attorney for Applicants

Assistant Commissioner for Patents  
Attn: Group Director  
Washington, D.C. 20231

TRANSMITTAL OF INFORMATION DISCLOSURE STATEMENT AFTER  
MAILING DATE OF FINAL ACTION OR NOTICE OF ALLOWANCE  
BUT BEFORE PAYMENT OF ISSUE FEE (37 C.F.R. 1.97(d))

**TIME OF TRANSMITTAL OF ACCOMPANYING  
INFORMATION DISCLOSURE STATEMENT**

1. The information disclosure statement transmitted herewith is being filed after a final action under §1.113, or a notice of allowance under §1.311, whichever occurs first, but before, or simultaneously with, the payment of the issue fee.

**STATEMENT, PETITION AND FEE**

2. In accordance with the requirements of 37 C.F.R. 1.97(d):
  - A. Accompanying this transmittal is a statement, as specified in 37 C.F.R. 1.97(e).
  - B. Applicant hereby petitions for the consideration of the accompanying information disclosure statement. 37 C.F.R. 1.97(d)(2).
  - C. Applicant submits the petition fee set forth in §1.17(i) (\$130).

**FEE DUE**

3. Petition fee due (§1.17(i)): \$130.00

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METHOD OF PAYMENT

4.    ☒ Attached is a check for \$130.00.  
      ☐ Charge Account 06-1135.  
      ☒ The Commissioner is hereby authorized to charge any additional fees which may be required in this application under 37 C.F.R. §§1.16-1.17 during its entire pendency, or credit any overpayment, to Deposit Account No. 06-1135. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 06-1135. A duplicate of this petition is attached.

  
By: James J. Schumann  
Registration No.: 20,836

FITCH, EVEN, TABIN & FLANNERY  
135 S. La Salle Street, Suite 900  
Chicago, IL 60603  
(619) 552-1311



DOCKET NO. 57714

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Dina Plunkett  
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(we)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant(s): Semple, et al.  
Serial No.: 08/837,042  
Filed: April 11, 1997  
For: GnRH ANTAGONISTS  
Group Art Unit: 1654  
Examiner: C. Delacrois-Muirhead

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10/13/98  
Date

James J. Schumann  
Registration No. 20,856  
Attorney for Applicants

Assistant Commissioner for Patents  
Washington, D.C. 20231

**STATEMENT FOR INFORMATION DISCLOSURE UNDER 37 C.F.R. 1.97(e)**

**IDENTIFICATION OF INFORMATION DISCLOSURE STATEMENT  
FOR WHICH THIS STATEMENT IS BEING MADE**

1. This statement is being made for the Information Disclosure Statement  
[X] accompanying this statement.  
[] filed on \_\_\_\_\_.

2. I, the person signing below state:

- that each item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of the information disclosure statement. 37 C.F.R. 1.97(e)(1).

**AND**

- that no item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application and to the knowledge of the person signing the statement after making reasonable inquiry, was known to any individual designated in §1.56(c) more than three months prior to the filing of the information disclosure statement. 37 C.F.R. 1.97(e)(2).

3. Enclosed is a copy of the search report issued by the European Patent Office in the corresponding international application which was mailed on July 29, 1998. In addition to the international application listed on the attached

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PTO-1449 and U.S. Patent No. 5,296,468 which was supplied as a part of original I.D.S., there are two references from the *Journal of Medicinal Chemistry* (categorized as "Y") which were known to one of the applicants (G. Jiang) and therefore are not included on the PTO-1449. These two articles were not originally supplied because they were and still are considered to be merely cumulative with the disclosures of U.S. Patents Nos. 5,296,468 and 5,506,207 from the standpoint of the subject matter being claimed in this application; however, from the standpoint of completeness, courtesy copies of these two articles are attached to the copy of the European Patent Office Search Report.

**IDENTIFICATION OF PERSON MAKING THIS STATEMENT**

The person making this statement is:

(a) ☐ the inventor(s) who signs below

\_\_\_\_\_  
(Inventor)

(b) ☐ a person who is substantively involved in the preparation or prosecution of the application, and who is associated with the inventor, with the assignee, or with anyone to whom there is an obligation to assign the application (37 C.F.R. 1.56(c)) and who signs below.

\_\_\_\_\_  
(Person who is signing)

(c) ☒ the practitioner who signs below on the basis of the information:

☐ supplied by the inventor(s).  
☐ supplied by an individual designated in §1.56(c).  
☒ in the practitioner's file.

  
\_\_\_\_\_  
James J. Schumann  
Registration No. 20,856

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(619) 552-1311



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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): GRAEME SEMPLE and  
GUANGCHENG JIANG  
Serial No.: 08/837,042  
Filed: April 11, 1997  
For: GnRH ANTAGONISTS  
Group Art  
Unit: 1654  
Examiner(s): C. Delacrois-Muirhead

SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT IN ACCORDANCE  
WITH 37 C.F.R. §§ 1.97(d)

Assistant Commissioner for Patents  
Washington, D.C. 20231

Dear Sir:

An Information Disclosure Statement was originally filed in the USPTO on July 10, 1997 and a Notice of Allowance was mailed on September 2, 1998. An International Search Report from the EPO was mailed on July 29, 1998.

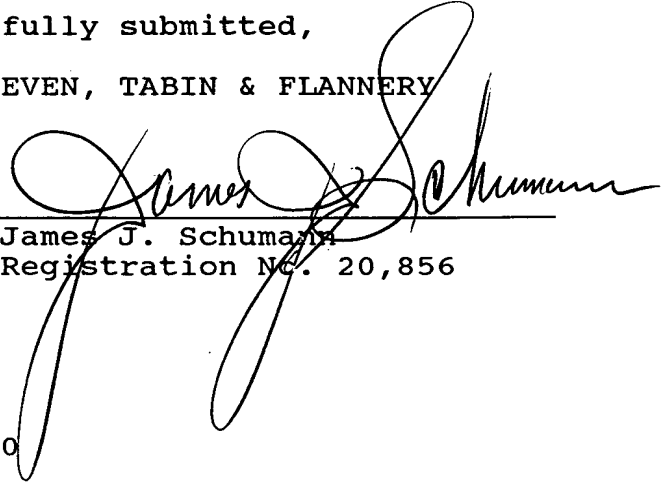
Enclosed herewith is a second U.S. Form PTO-1449 which lists the additional reference cited in that International Search Report that Applicants request be considered, a copy of which reference is being filed along with this paper. The reference fails to disclose GnRH antagonists having the 5-position substituents recited in the allowed claims as a part

of such an overall combination of residues in a decapeptide or the like.

Respectfully submitted,

FITCH, EVEN, TABIN & FLANNERY

By:

  
James J. Schumann  
Registration No. 20,856

October 13, 1998

Address all correspondence to:

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